

## **REMARKS**

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the comments which follow.

Claims 1, 2, and 4-28 were pending in this application. In this response, claims 1, 15 and 27 have been amended and claim 28 canceled. Thus, claims 1, 2 and 4-27 remain pending.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure:

Entry of this Amendment is proper under 37 C.F.R. § 1.116 for at least the following reasons. First, the amendments address the new grounds of rejection under 35 U.S.C. § 101 and § 112. Second, the amendments raise no new issues that would necessitate further search and/or substantive reexamination. Third, the amendments clearly overcome the grounds of rejection.

## ***REJECTIONS UNDER 35 U.S.C. § 101***

Claims 1-2 and 4-28 are rejected under 35 U.S.C. §101 as being nonstatutory for reasons presented at page 3 of the Official Action. While not conceding the merits of the rejection, the Applicant has amended the independent claims and claim 27 to address the points noted by the Examiner and for clarity purposes. The claims are directed to a machine. The noted phrase has been amended to indicate that the machine has a cutting insert holder that is radially adjustable. Thus, the claims are directed to a machine and satisfy § 101. Reconsideration and withdrawal of this rejection are respectfully requested.

***REJECTION UNDER 35 U.S.C. § 112***

Claims 1-2 and 4-28 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention on the grounds set forth on page 3 of the Official Action. These claim rejections have been addressed by the above amendments. Reconsideration and withdrawal of the rejection is respectfully requested.

***ALLOWABLE SUBJECT MATTER***

It is noted with thanks the comments in paragraph 5 that claims 5, 9, 11-13, 18-20 and 22 would be allowable if the rejections of under §§ 101 and 112 are overcome. As those rejections have been suitably addressed herein, an indication of allowability of these claims is respectfully requested.

***REJECTIONS UNDER 35 U.S.C. § 103***

The present invention relates to a boring tool with a base body whose front surface can accommodate at least one cutting insert holder. Such a tool can for example be used to expand a predrilled hole.

In order to drill corresponding holes or to expand them, it is necessary to adjust the cutting insert holders at least in the radial direction. However, such an adjustment can be performed with the known drilling tools only with great effort, generally using a pre-adjusting device which is very time consuming.

With known drilling tools in general there is no possibility of radially adjusting the relative radial displacement of the cutting insert such that the device provides a measure by mechanical means of the radial deviation with respect to the base body. Such a feature permits fine adjustment of the cutting inserts on the base body, without removing the base body from the machine.

According to the present invention at least one adjusting pin connected to the base body is provided which axially overlaps the cutting insert holder and/or the cutting insert, in such a way that the radial adjustment of the cutting insert holder with respect to the base body can be carried out by measuring the radial deviation between a defined point of the cutting insert holder or a defined point on the cutting insert accommodated on the cutting insert holder and the adjusting pin.

To this end the adjusting pin protrudes axially past at least a portion of an upper surface of the cutting insert holder.

Claims 1-2, 4, 7-8, 10, 14, 27, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over German 2,746,232 in view of EP 344,616 on the grounds set forth at pages 3 and 4 of the Official Action. Claims 1-2, 4, 7-8, 10, 14, 27, and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over German 2,746,232 in view of *Schürfeld 5,716,169* on the grounds set forth at page 5 of the Official Action. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over German 2,746,232 in view of *Schürfeld 5,716,169* as applied to claim 1 above, and further in view of Healy 2,204,855 on the grounds set forth at pages 5 and 6 of the Official Action. Finally, claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over

German 2,746,232 in view of EP 344,616 as applied to claim 1 above, and further in view of Healy 2,204,855 on the grounds set forth at page 6 of the Official Action. Each of these rejections are respectfully traversed.

First, it is respectfully asserted that in contrast to the presently claimed base body and drilling tool, stop cam 4 of *DE '232* does not protrude past a portion of the upper surface of the insert holder. Furthermore, it is not obvious to manufacture the stop cam 4 of *DE '232* of a length, so that the stop cam would protrude past a portion of an upper surface of the insert holder, as would be required by any modification of *DE '232* to arrive at the present claims. The post cam 4 of *DE '232* only has the function to provide a locating face for the threaded pins 15. The stop cam 4 is not used as an adjusting pin, so that there is no cause for amending the length of said pin. There is clearly no teaching in the other cited prior art as a whole that would or even could have prompted the skilled person to modify the stop cam, in order to arrive at something falling within the terms of the claims, and with achieving what the presently claimed invention achieves.

Moreover and as a threshold matter, a person skilled in the art would not have adapted or modified said stop cam, since he could not be in expectation of some improvement or advantage; *DE '232* does not mention any problems with the radial adjustment. *Contra KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, (2007).

In addition to *DE '232*, the Examiner has cited to several patents related to cutting tools in support of the rejections. However, these patents generally disclose boring tools, which do not incorporate the features of the claims. In general and with respect to the radially adjustable feature, boring tools do not incorporate such a feature. In such boring tools, which carry an even

number of cutting insert holders, each cutting insert encounters a diametrically facing cutting insert and the diameter may be determined by measuring the radial distance between two facing cutting edges. However, this adjustment procedure requires each cutting insert to be associated with a diametrically facing cutting insert, and the procedure, therefore, only offers the possibility of adjusting two cutting inserts with respect to one another, not however with respect to the base body.

For adjusting the cutting inserts on the base body, therefore generally the base body must be separated from the drive and mounted in a so called pre-adjusting device, so that adjustment can take place by way of measurements obtained using optical methods as for example described by *Schürfeld*. Similar comments and observations can be made with respect to the boring tool in *EP '616* and in *Healy*.

In view of at least the above noted patentable distinctions over the proposed combination of cited references, it is respectfully requested that the rejections of claims 1-2, 4, 6-8, 10, 14, 27, and 28 be reconsidered and withdrawn.

## ***CONCLUSION***

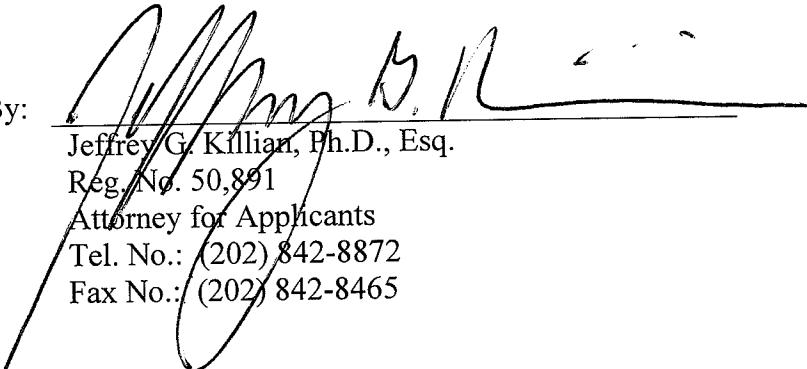
Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, it is respectfully requested that the undersigned be contacted at the number indicated below.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0573. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,

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